

Remarks

Upon entry of the foregoing amendment, claims 6-10 and 12-19 are pending in the application, with claims 6, 10 and 14 being the independent claims. Claims 1-5 and 11 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein.

Claim 6 is currently amended to use the transitional phrase "consisting essentially of," and to add the name of the compound of formula (I), "trifloxystrobin." Support for the amendments to claim 6 can be found in the originally filed claim 1 and the specification at page 1, lines 22-26.

Claims 10 and 13 are currently amended. Support for the amendments to claim 10 can be found in the specification at page 4, lines 27-32 and page 3, lines 1-7. Support for the amendments to claim 13 can be found in the specification at page 4, lines 27-29.

These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

I. Description of the Invention

Applicants' invention is directed to an active compound combination, consisting essentially of trifloxystrobin (compound of formula (I)) and prothioconazole (compound of formula (II)); a fungicidal composition, comprising trifloxystrobin, prothioconazole, and optionally one or more extenders and/or surfactants; and a method of controlling

fungi, comprising applying trifloxystrobin and prothioconazole to the fungi and/or their habitat.

II. Supplemental Information Disclosure Statement

Applicants note that a Second Supplemental Information Disclosure Statement is submitted accompanying the Amendment and Reply. Applicants respectfully request the Examiner initial and return a copy of Information Disclosure Statement Forms.

III. Rejection under 35 U.S.C. § 112, First Paragraph

Claims 10-19 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. Applicants respectfully traverse this rejection.

The cancellation of claim 11 renders the rejection of claim 11 moot.

The Examiner alleged that:

The mixtures and methods are not shown to be synergistic. Synergy depends on effects on a specific pest; not required as claimed. One is told to perform experimentation to determine whether or not synergy exists. It would require an excessive degree of experimentation to identify each and every fungal organism in each and every growth stage, on each and every part of a plant, or soil types, or storage areas at each of the required dosage ranges, to determine, which if any, are synergistic.

(Office Action, page 2.) Applicants respectfully disagree.

In order to satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph, the claimed invention must be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *See In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The factors that can be considered in determining whether an amount of experimentation is undue have been set forth in *In re Wands*, 858

F.2d at 737, 8 U.S.P.Q.2d at 1404. Among these factors are: (1) the level of one of ordinary skill; (2) the amount of direction provided by the inventor; and (3) the existence of working examples. The test for undue experimentation is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine. *See id.*

The Examiner was of the opinion that "[t]he relative skill of those in the art is high." (Office Action, page 2.) The specification provides ample guidance as to how to make and use the claimed combination, how to test the fungicidal activities of the claimed combination and how to determine whether the claimed combination has synergistic effect or not. The specification describes the weight ratios of trifloxystrobin to prothioconazole, at which the synergistic effect can be obtained. (Specification at page 3, lines 1-7). The specification also discloses the types of fungi and cereal diseases that can be controlled by applying the claimed combination as well as the dosage ranges. (*Id.* at page 3, lines 9-21 and page 6, lines 23-31.) The specification further discloses two examples illustrating how to make and use the claimed invention. (*Id.* at pages 8-11, Examples A and B). The specification in addition discloses a method (using the Colby formula) to evaluate whether the claimed combination has a synergistic effect. (*Id.* at page 7, lines 1-30.) Therefore, following the guidance provided in the specification, a person of ordinary skill in the art could have made and used the claimed combination, tested its activities and determined its synergistic effect by merely routine experimentation.

In addition, solely to expedite the prosecution of this application and not in acquiescence of the Examiner's rejection, claim 10 is currently amended to recite the

weight ratios of trifloxystrobin to prothioconazole. Thus, the claim no longer recites "in a synergistically effective amount."

In summary, Applicants respectfully submit that, at the time the present application was filed, it would have required no more than routine experimentation for a skilled artisan to practice the full scope of the claimed invention in view of the teachings in the specification and the knowledge available in the art. Accordingly, Applicants respectfully request the rejection be withdraw.

IV. Rejections under 35 U.S.C. § 103

A. Rejection under 35 U.S.C. § 103 in View of Zimmerman

Claims 6-19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zimmerman (U.S. Patent No. 7,179,824 B2) ("Zimmerman"). (Office Action, page 3.) Applicants respectfully traverse this rejection.

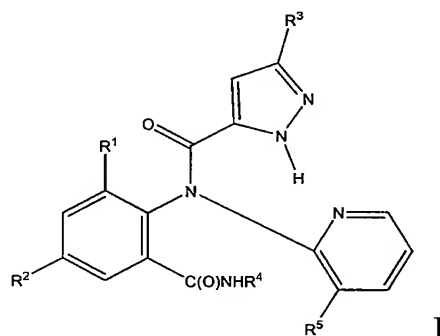
The cancellation of claim 11 renders the rejection of claim 11 moot.

(a) Prima Facie Case of Obviousness Has Not Been Established

In response to *KSR International Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 U.S.P.Q. 2d 1385 (USSC) (2007), the Office issued "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. V. Teleflex Inc.*" 72 Fed. Reg. 195, pages 57526-57535 (October 10, 2007)("Guidelines"). The Guidelines reiterate and emphasize the Examiner's role as a factfinder, using the factual inquiries set forth in *Graham*. Based on the fact record, the Examiner must use "articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness." *Guidelines* at 57529 col. 1 (internal citation omitted).

Zimmerman is directed to a compound of Formula I (its N-oxide or salt), a composition comprising a compound of Formula I, and its use in controlling arthropods:



(Zimmerman at col. 1, line 50, through col. 2, line 56.) Zimmerman also generally discloses that a compound of Formula I can be mixed with one or more other biologically active compounds or agents including insecticides, fungicides, nematocides, bactericides, acaricides, growth regulators, chemosterilants, semiochemicals, repellents, attractants, pheromones, feeding stimulants or other biologically active compounds to form a multi-component pesticide. (*Id.* at col. 32, lines 44-52.) Prothioconazole and trifloxystrobin are mentioned along with over 100 other fungicides. (*Id.* at col. 33, lines 15-46; and lines 41 and 45.) Zimmerman further discloses preferred and most preferred mixtures of a compound of Formula I and other biologically active compounds. (*Id.* at col. 34, lines 31-67.) None of the listed preferred mixtures contain either prothioconazole or trifloxystrobin.

Under *KSR*, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art."

KSR, 127 S. Ct. at 1741. Rather, there must be a reason or rationale behind an obviousness determination and "this analysis should be made explicit." *Id.* Hence, under *KSR*, the mere fact that the individual active compounds, trifloxystrobin and prothioconazole were independently known in the art does not render claims 6-10 and 12-19 obvious. The Examiner reasoned that, "[t]he instant invention provides well known old art recognized compounds, with well known art recognized effects, applied by well known art recognized methods to achieve improved control as is well known in the art." (Office Action, page 4.) Applicants respectfully submit that the Examiner's general statement does not provide an identified reason "that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Guidelines* at 57529 col. 2. The Examiner used impermissible hindsight analysis to piece together isolated elements (*i.e.*, trifloxystrobin and prothioconazole) taken from Zimmerman with the aid of Applicants' disclosure to arrive at presently claimed combination.

As discussed above, Zimmerman **does not** specifically disclose a ternary active compound combination of a compound of Formula I, trifloxystrobin and prothioconazole. Even assuming, *arguendo*, that Zimmerman teaches a ternary active compound combination of a compound of Formula I, trifloxystrobin and prothioconazole, Zimmerman **does not** provide a reason for making presently claimed combination consisting essentially of trifloxystrobin and prothioconazole, **without a compound of Formula I**. Thus, for at least these reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of present claims 6-10 and 12-19.

In addition, present claims 7, 10 and 12 require specific mixing ratios of trifloxystrobin to prothioconazole. Zimmerman is completely silent with respect to the mixing ratios of trifloxystrobin to prothioconazole as recited in present claims 7, 10 and 12. Thus, such mixing ratios were not disclosed by Zimmerman. Applicants respectfully submit that to establish *prima facie* obviousness of a claimed invention, all claim limitations must be considered (*See* MPEP 2143.03) and "all the claimed elements were known in the prior art" (*see* Guidelines at 57529 col. 2). Thus, for at least these additional reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of present claims 7, 10 and 12.

(b) *The Record Provides Clear Evidence of Unexpected Results That Rebut Any Prima Facie Case of Obviousness*

As discussed above, the Examiner has not established a *prima facie* case of obviousness of claims 6-10 and 12-19. Moreover, the record clearly demonstrates that *prima facie* obviousness, even if it were established, is overcome by the synergistic, unexpected results obtained with the claimed combination. The synergistic effects have long been recognized as an indicator of non-obviousness. *See In Re Luvisi*, 144 U.S.P.Q. 646, 651-653 (CCPA 1965); *In re Lemin*, 408 F.2d 1045, 1049 (CCPA, 1969).

1. *Method of Demonstrating Synergism*

"There are undoubtedly many appropriate methods of demonstrating synergism. In each case, however, the facts shown must be analyzed to determine whether the method chosen in that case has in fact clearly and convincingly demonstrated the existence of synergism or, more generally speaking, an unobvious result." *Ex parte Quadranti*, 25 U.S.P.Q.2d 1071, 1072-1073 (1992).

For example, synergism is shown where "the combined action of two or more agents. . . that is greater than the sum of the action of one of the agents used alone." *In Re Luvisi*, 144 U.S.P.Q. at 652.

Synergism of a given composition containing two or more active fungicidal compounds can be demonstrated by comparing the observed fungicidal activity of the composition to the calculated fungicidal activity according to the Colby formula. If the observed fungicidal activity is greater than that calculated, then the composition has a synergistic effect. Specifically, for a composition that contains two active fungicidal compounds, the calculated fungicidal activity is:

$$E1 = X + Y - \frac{X \cdot Y}{100}$$

wherein X denotes the efficacy when employing active compound A in a concentration of m g/ha,¹ Y denotes the efficacy when employing active compound B in a concentration of n g/ha, and E1 denotes the efficacy when employing active compounds A and B in a concentrations of m and n g/ha. (Specification at page 7.)

2. Synergistic Effect Presented in the Specification

The specification includes 2 examples to demonstrate the synergistic effect obtained with presently claimed combination.

(i) *Leptosphaeria Nodorum* Test

In this study, young wheat plants were treated with trifloxystrobin (100 g/ha), (100 g/ha) prothioconazole individually, or with a preparation of the claimed

¹ The unit "g/ha" means gram per gram per hectare.

combination (54 g/ha trifloxystrobin + 46 g/ha prothioconazole, wherein the ratio of trifloxystrobin to prothioconazole was 1:0.85 (54 g/ha : 46 g/ha)). The treated plants were then sprayed with a spore of *Leptosphaeria nodorum*. The efficacy of fungi control was evaluated 10 days after the inoculation. (Specification at pages 8 and 9, Example A and Table A.)

As shown in Table A, when applied individually at 100 g/ha, efficacies of 67% and 56% were observed for trifloxystrobin and prothioconazole, respectively.² Assuming a linear dose-response correlation, when applied individually at an application rate of 54 g/ha, trifloxystrobin has an expected efficacy of about 36% $[(54/100) \times 67\%]$; and when applied individually at an application rate of 56 g/ha, prothioconazole has an expected efficacy of about 26% $[(46/100) \times 56\%]$, with a sum of the expected efficacy of trifloxystrobin and prothioconazole being 63% $(36\% + 26\% = 63\%)$. In comparison, as shown in Table A, an efficacy of 89% was observed when the claimed combination was applied. Thus, the efficacy of the claimed combination (89%) was much greater than the sum of the efficacy of trifloxystrobin and prothioconazole applied individually (63%). Therefore, the claimed combination (the weight ratio of trifloxystrobin to prothioconazole being 1:0.85) has a synergistic effect against *Leptosphaeria nodorum* on wheat plants, according to the definition of synergism in *In Re Luvisi*.

Alternatively, the synergistic effect of the present invention as exemplified in Example A can be explained in a different way. As shown in Table A, when applied individually at 100 g/ha, efficacies of 67% and 56% were observed for trifloxystrobin

² An efficacy of 0% corresponds to that of control, and an efficacy of 100% indicates that no infection was observed. (Specification at page 8, lines 21-23.)

and prothioconazole, respectively. Therefore, trifloxystrobin is a more potent fungicidal compound against *Leptosphaeria nodorum* as compared to prothioconazole. While keeping the application rate at 100 g/ha, but substituting the more potent trifloxystrobin with 46 g of less potent prothioconazole, the resulted combination had an efficacy of 89%, much greater than that of even the more potent trifloxystrobin applied at 100 g/ha, *i.e.*, 67%. The improved efficacy can only be the result of a synergistic effect between the two compounds, because in the absence of a synergistic effect, the combination would have been expected to have a lower efficacy than that of trifloxystrobin. Therefore, the claimed invention has a synergistic effect against *Leptosphaeria nodorum* on wheat plants.

(ii) *Puccinia Recondita* Test

In this study, young wheat plants were first inoculated with *Puccinia recondita*, and then treated with trifloxystrobin (25 g/ha) and prothioconazole (25 g/ha) individually, or with the preparation of claimed combination (8.5 g/ha trifloxystrobin + 16.5 g/ha prothioconazole, wherein the ratio of trifloxystrobin to prothioconazole was about 1: 2 (8.5 g/ha : 16.5 g/ha))). The efficacy of fungi control was evaluated 10 days after the inoculation. (Specification at pages 10 and 11, Example B and Table B.)

As shown in Table B, when applied individually, efficacies of 0% and 43% were observed for trifloxystrobin and prothioconazole, respectively. Assuming a linear dose-response correlation, when applied individually at an application rate of 8.5 g/ha, trifloxystrobin has an expected efficacy of 0% $[(8.5/25) \times 0\%]$; and when applied individually at an application rate of 16.5 g/ha, prothioconazole has an expected efficacy of about 28% $[(16.5/25) \times 43\%]$, with a sum of the expected efficacy of trifloxystrobin

and prothioconazole being 28% ($0\% + 28\% = 28\%$). In comparison, as shown in Table B, an efficacy of 71% was observed when the claimed combination was applied. Thus, the efficacy of the claimed combination (71%) was much greater than the sum of the efficacy of trifloxystrobin and prothioconazole applied individually (28%). Therefore, the claimed combination (the weight ratio of trifloxystrobin to prothioconazole being about 1:2) has a synergistic effect against *Puccinia recondita* on wheat plants, according to the definition of synergism in *In Re Luvisi*.

Alternatively, the synergistic effect of the present invention as exemplified in Example B can be explained in a different way. As shown in Table B, when applied individually at 25 g/ha, efficacies of 0% and 43% were observed for trifloxystrobin and prothioconazole, respectively. Therefore, prothioconazole is a more potent fungicidal compound against *Puccinia recondita* as compared to trifloxystrobin. While keeping the application rate at 25 g/ha, but substituting the more potent prothioconazole with 8.5 g of less potent trifloxystrobin, the resulted combination had an efficacy of 71%, much greater than that of even the more potent prothioconazole applied at 25 g/ha, *i.e.*, 43%. The improved efficacy can only be the result of a synergistic effect between the two compounds, because in the absence of a synergistic effect, the combination would have been expected to have a lower efficacy than that of prothioconazole. Therefore, the claimed invention has a synergistic effect against *Puccinia recondita* on wheat plants.

The Examiner alleged that "Applicant has not provided any objective evidence of criticality, nonobvious or unexpected results that the administration of the particular ingredients' or concentrations provides any greater or different level of prior art expectation as claimed, . . ." (Office Action, page 4.) Applicants respectfully disagree.

As discussed above, Applicants have clearly and convincingly demonstrated (by more than one appropriate method) unexpected synergistic effects obtained from the claimed combination at different mixing ratios of trifloxystrobin to prothioconazole, against different fungi. The unexpected synergist effects overcome the obviousness rejection of claims 6-10 and 12-19, assuming a *prima facie* case of obviousness was established. Accordingly, Applicants respectfully request this rejection be withdrawn.

B. Rejection under 35 U.S.C. § 103 in View of Fischer

Claims 6-19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fischer *et al.* (U.S. Patent Appl. Pub. No. 2004/0102326 A1) ("Fischer"). (Office Action, page 4.) Applicants respectfully traverse this rejection.

The cancellation of claim 11 renders the rejection of claim 11 moot.

The present application is the U.S. National Phase of Int'l Appl. No. PCT/EP2003/006174, filed on June 12, 2003. Thus, the present application has U.S. filing date of June 12, 2003. Fischer is the U.S. National Phase of Int'l Appl. No. PCT/EP01/11126 filed on September 26, 2001 and was published as WO 02/30199 A1 in *German* on April 18, 2002. Thus, Fischer is disqualified as a prior art under 35 U.S.C. § 102(e). In addition, Fischer is disqualified as a prior art under 35 U.S.C. § 102(a) or 102(b), because it was published on May 27, 2004, after the U.S. filing date of the present application, June 12, 2003. Accordingly, Applicants respectfully submit that the rejection is improper and must be withdrawn.

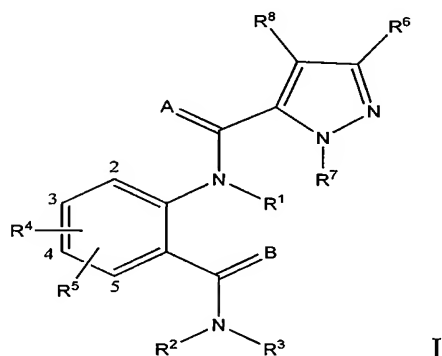
C. Rejection under 35 U.S.C. § 103 in View of Berger

Claims 6-19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berger *et al.* (U.S. Patent Appl. Pub. No. 2004/0209923 A1) ("Berger"). (Office Action, page 5.) Applicants respectfully traverse this rejection.

The cancellation of claim 11 renders the rejection of claim 11 moot.

(a) Prima Facie Case of Obviousness Has Not Been Established

Berger is directed to compounds of Formula I (their N-oxide or salt), compositions comprising a compound of Formula I, and their use for protecting a propagule or a plant grown therefrom from an invertebrate pest:



(Berger, paras. 0006-0025.) Berger also generally discloses a composition comprising a compound of Formula I and at least one other biologically active compound or agent, including insecticides, fungicides, nematocides, bactericides, acaricides, growth regulators, chemosterilants, semiochemicals, repellents, attractants, pheromones, feeding stimulants or other biologically active compounds. (*Id.* at paras. 0259 and 0273.) Prothioconazole and trifloxystrobin are mentioned along with over 100 other fungicides. (*Id.*)

For the same reasons stated above in Zimmerman, the mere fact that the individual active compounds, trifloxystrobin and prothioconazole were independently known in the art does not render claims 6-10 and 12-19 obvious. The Examiner reasoned that "[t]he instant invention provides well known old art recognized compounds, with well known art recognized effects, applied by well known art recognized methods to achieve improved control as is well known in the art." (Office Action, page 6.) Applicants respectfully submit that the Examiner's general statement does not provide an identified reason "that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Guidelines* at 57529 col. 2. The Examiner used impermissible hindsight analysis to piece together isolated elements (*i.e.*, trifloxystrobin and prothioconazole) taken from Berger with the aid of Applicants' disclosure to arrive at presently claimed combination.

As discussed above, Berger ***does not*** specifically disclose a ternary active compound combination of a compound of Formula I, trifloxystrobin and prothioconazole. Even assuming, *arguendo*, that Berger teaches a ternary active compound combination of a compound of Formula I, trifloxystrobin and prothioconazole, Berger ***does not*** provide a reason for making presently claimed combination consisting essentially of trifloxystrobin and prothioconazole, ***without a compound of Formula I***. Thus, for at least these reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of present claims 6-10 and 12-19.

In addition, present claims 7, 10 and 12 require specific mixing ratios of trifloxystrobin to prothioconazole. Berger is completely silent with respect to the mixing

ratios of trifloxystrobin to prothioconazole as recited in present claims 7, 10 and 12. Thus, such mixing ratios were not disclosed by Berger. Applicants respectfully submit that to establish *prima facie* obviousness of a claimed invention, all claim limitations must be considered (*See* MPEP 2143.03) and "all the claimed elements were known in the prior art" (*see* Guidelines at 57529 col. 2). Thus, for at least these additional reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of present claims 7, 10 and 12.

(b) *The Record Provides Clear Evidence of Unexpected Results That Rebut Any Prima Facie Case of Obviousness*

As discussed above, the Examiner has not established a *prima facie* case of obviousness of claims 6-10 and 12-19. Moreover, for the same reasons stated above in Zimmerman, the record clearly demonstrates that *prima facie* obviousness, even if it were established, is overcome by the synergistic, unexpected results obtained with the claimed combination. Accordingly, Applicants respectfully request this rejection be withdrawn.

V. *Provisional Double Patenting Rejections*

A. *Rejections in View of the Application No. 10/505,440*

Claim 10 was provisionally rejected on the ground of statutory double patenting over claim 2 of co-pending Application No. 10/505,440 ("the '440 application"). Claims 6-19 were provisionally rejected on the ground of non-statutory double patenting over claims 1, 7-9, 11 and 12 of the '440 application. Applicants respectfully traverse this rejection.

The cancellation of claim 11 renders the rejection of claim 11 moot.

The '440 application is assigned to BASF AKTIENGESELLSCHAFT according to the records of USPTO (reel/frame 016179/0960), and names AMMERMANN, Eberhard; STIERL, Reinhard; LORENZ, Gisela; STRATHMANN, Siegfried; SCHELBERGER, Klaus; SPADAFORA, V. James; and CHRISTEN, Thomas as the inventors.

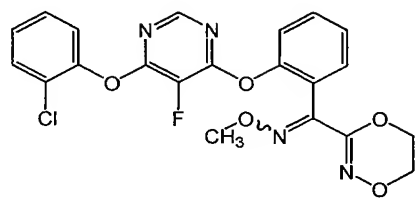
The present application is assigned to BAYER CROPSCIENCE AG (reel/frame 017063/0212), and names WACHENDORFF-NEUMAN, Ulrike; MAULER-MACHNIK, Astrid; and JAUTELAT, Manfred as the inventors. Thus, the present application and the '440 application *are not* filed by "the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee, or that claim an invention resulting from activities undertaken within the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(2) and (3), that would raise an issue of double patenting if one of the applications became a patent." (MPEP 804.) Accordingly, Applicants respectfully submit that the provisional double patenting rejections are improper and must be withdrawn.

B. Rejection in View of the Application No. 10/563,328

Claims 6-10, 13 and 14 were provisionally rejected on the ground of non-statutory double patenting over claims 1, 4 and 8-10 of co-pending Application No. 10/563,328 ("the '328 application"). Applicants respectfully traverse this rejection.

Claim 8 of the '328 application has been cancelled. Claims 1, 4, 9 and 10 of the '328 application recite:

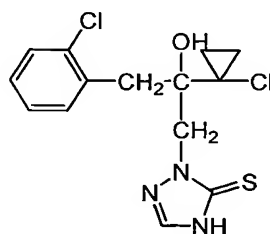
1. A formulation comprising
 - a) Fluoxastrobin



- b) optionally a penetration promoter,
- c) optionally an emulsifier, and
- d) optionally additives,

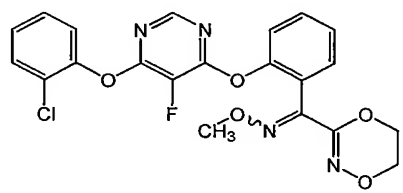
wherein the formulation contains γ -butyrolactone and at least one ethylene diamine alkoxyate, which acts as an emulsion stabiliser or a crystallisation inhibitor, or both.

4. The formulation according to claim 1 or 3, further comprising Prothioconazole



9. A method for producing the formulation according to claim 1, comprising mixing

- a) Fluoxastrobin



- b) optionally a penetration promoter,
- c) optionally an emulsifier,
- d) optionally additives,
- e) γ -butyrolactone, and
- f) an emulsion stabiliser or a crystallisation inhibitor, or both.

10. A method of plant protection comprising contacting agrochemical formulations according to claim 1 to a plant or a plant habitat, or both.

(The '328 application, Response to Non-Final Office Action submitted on June 5, 2009.)
Thus, each of claims 1, 4, 9 and 10 of the '328 application requires *fluoxastrobin*. Specifically, claim 4 of the '328 application requires a formulation comprising *fluoxastrobin* and prothioconazole. In contrast, as discussed above, present claims 6-10, 13 and 14 are directed to an active compound combination, consisting essentially of *trifloxystrobin* and prothioconazole. Thus, claims 1, 4, 9 and 10 of the '328 application are patentably distinct from claims 6-10, 13 and 14 of the present application as they are drawn to completely different subject matter. Accordingly, Applicants respectfully request this rejection be withdrawn.

C. Rejection in View of the Application No. 10/518,668

Claims 6-19 were provisionally rejected on the ground of non-statutory double patenting over claims 9-12, 14 and 15 of co-pending Application No. 10/518,668.

The cancellation of claim 11 renders the rejection of claim 11 moot.

Application No. 10/518,668 was abandoned on April 29, 2008. Accordingly, this rejection is moot and must be withdrawn.

D. Rejection in View of the Application No. 10/518,669

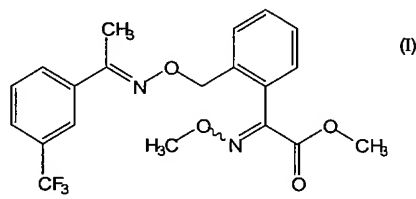
Claims 6-19 were provisionally rejected on the ground of non-statutory double patenting over claims 6-9 of co-pending Application No. 10/518,669 (the '669 application). Applicants respectfully traverse this rejection.

The cancellation of claim 11 renders the rejection of claim 11 moot.

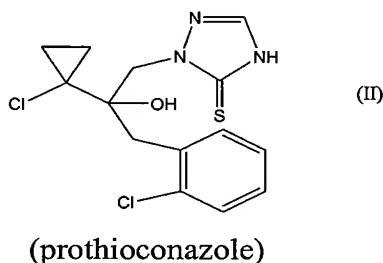
Claims 6-9 of the '669 application recite:

6. A synergistically effective active compound combination, comprising:

(1) a compound of formula (I)

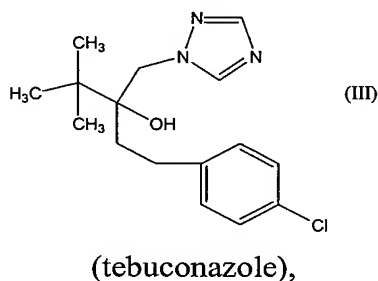


(2) a compound of formula (II)



and

(3) a compound of formula (III)



wherein the weight ratio of the compound of formula (I) to the compound of formula (II) is from 1:0.1 to 1:10 and the weight ratio of the compound of formula (I) to the compound of formula (III) is from 1:0.1 to 1:10.

7. The active compound combination of Claim 6 in which the weight ratio of the compound of formula (I) to the compound of formula (II) is from 1:0.2 to 1:5 and the weight ratio of the compound of formula (I) to the compound of formula (III) is from 1:0.2 to 1:5.

8. A method for controlling fungi comprising allowing an effective amount of an active compound combination according to Claim 6 to act on the fungi and/or their habitat.

9. A process for preparing fungicidal compositions comprising mixing one or more active compound combinations according to

Claim 6 with one or more extenders, surfactants or a combination
of one or more extenders and surfactants.

(The '669 application, Amendment and Reply submitted on December 9, 2008.) Each of claims 6-9 of the '669 application requires three components: trifloxystrobin, prothioconazole and tebuconazole, while presently claimed combination consisting essentially of just trifloxystrobin and prothioconazole. Thus, claims 6-9 of the '669 application are patentably distinct from present claims 6-10 and 12-19 as they are drawn to completely different subject matter. In addition, for the similar reasons stated above in Zimmerman and/or Berger, present claims 6-10 and 12-19 are not obvious in view of the '669 application, because: (1) the '669 application does not provide a reason for making presently claimed combination consisting essentially of trifloxystrobin and prothioconazole, and therefore no *prima facie* case of obviousness of present claims 6-10 and 12-19 was established; and (2) the unexpected synergist effects obtained with the claimed combination overcome the obviousness rejection, assuming a *prima facie* case of obviousness was established. Accordingly, Applicants respectfully request this rejection be withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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